

REMARKS

Claims 35-37 are amended to expressly recite the members of the previously recited group. Applicants submit that no new matter is added, and request entry of the amendment.

35 U.S.C. §§ 102(b) and (e)

Claims 20, 32, and 36 are rejected under 35 U.S.C. § 102(b) as anticipated by Mittman et al. (US 6821724). The Examiner asserts that SEQ ID NO:11659 of Mittman comprises at least 8 bases selected from SEQ ID NOs: 59-65, and comprises at least 8 nucleobases which are antisense to nucleobases 263-326 of SEQ 17. Applicants respectfully traverse.

Claim 20 recites in part “wherein said nucleobase sequence of said oligonucleotide is 100% complementary to SEQ ID NO:17 as measured over the entirety of said oligonucleotide.” According to the alignment provided by the Examiner, there are 2 mismatches between SEQ ID NO: 11659 of Mittman and SEQ ID NO: 17 – less than 100% complementary to SEQ ID NO:17. Thus, an oligonucleotide of SEQ ID NO: 11659 of Mittman does not satisfy at least this limitation of claim 20, or the claims which depend therefrom or otherwise incorporate all the limitations of claim 20. For at least this reason, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 20, 32, and 36 under 35 U.S.C. § 102(b) as anticipated by Mittman et al. (US 6821724).

Claims 20, 32 and 36 are rejected under 35 U.S.C. § 102(e) as anticipated by Velculescu et al. (US 2007/0031851). The Examiner asserts that SEQ ID NOs 3525 and 9983 of the reference comprise at least 8 bases selected from SEQ ID NOs: 59-65, and comprises at least 8 nucleobases which are antisense to nucleobases 263-326 of SEQ 17. Applicants respectfully traverse.

Claim 20 recites in part, “an oligonucleotide consisting of 12 to 30 linked nucleosides.” According to the alignment provided by the Examiner, SEQ ID NOs 3525 and 9983 of Velculescu are each only 10 bases long. Thus, an oligonucleotide of SEQ ID NO: 3525 or 9983 of Velculescu does not satisfy at least this limitation of claim 20, or the claims which depend therefrom or otherwise incorporate all the limitations of claim 20. For at least this reason, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of

claims 20, 32 and 36 under 35 U.S.C. § 102(e) as anticipated by Velculescu et al. (US 2007/0031851).

35 U.S.C. § 103(a)

Claims 20-36 are rejected under 35 U.S.C. § 103(a) as obvious over Mittman et al. (US 6821724) and Velculescu et al. (US 2007/0031851) in view of McKay et al. (US 6133246). Mittman and Velculescu are applied as above. The Examiner states that these references do not disclose modified oligonucleotides. The Examiner cites McKay for disclosure of modifications and gapmers, which the Examiner asserts would have been obvious to incorporate into oligonucleotides for enhancing their target binding and stability for nuclease degradation. *Office Action* at page 4-5. Applicants respectfully traverse.

Even if *arguendo* there were a motivation to modify an oligonucleotide of SEQ ID NO: 11659 of Mittman or SEQ ID NO: 3525 or 9983 of Velculescu to include 2'-O-MOE sugar moieties, phosphorothioate linkages, 5'-methyl cytosines, chimeric or gapmer structures based on McKay as suggested by the Examiner, the modified oligonucleotides would not satisfy the limitations of the pending claims.

As stated above, an oligonucleotide of SEQ ID NO: 11659 of Mittman does not satisfy at least the limitation of claim 20, "wherein said nucleobase sequence of said oligonucleotide is 100% complementary to SEQ ID NO:17 as measured over the entirety of said oligonucleotide," and an oligonucleotide of SEQ ID NO: 3525 or 9983 of Velculescu does not satisfy at least the limitation of claim 20, "an oligonucleotide consisting of 12 to 30 linked nucleosides." These deficiencies in the disclosures of Mittman and Velculescu are not remedied by the disclosure in McKay of oligonucleotide modifications relied on by the Examiner.

Nor has the Examiner provided any reason one of skill in the art would modify the SEQ ID NO: 11659 of Mittman to be 100% complementary to SEQ ID NO: 17. Applicants submit that there would be no motivation to do so as the alignment provided by the Examiner characterizes SEQ ID NO: 11659 as a "Mouse gene-specific probe/PCR primer," while SEQ ID NO: 17 is a human sequence. Similarly, the Examiner has not provided any reason for one of skill in the art to modify SEQ ID NO: 3525 or 9983 of Velculescu to satisfy the size or

complementarity limitations of claim 20, as these sequences appear to be from yeast, based on the information provided in the Examiner's alignment.

For at least this reason, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 20-36 under 35 U.S.C. § 103(a) as obvious over Mittman et al. (US 6821724) and Velculescu et al. (US 2007/0031851) in view of McKay et al. (US 6133246).

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Patents and Applications

Applicants wish to draw the Examiner's attention to the following patent(s) or application(s). Applicants encourage the Examiner to review and monitor the prosecution of the following patent(s) and/or application(s) throughout the pendency of this application.

Patent/Serial No.	Title	Issued/Filed
09/908,147	Antisense modulation of BCL2-associated X protein expression	07-17-2001

Application No.: 10/728,509
Filing Date: December 5, 2003

CONCLUSION

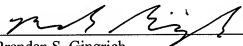
In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 
Brenden S. Gingrich
Registration No. 60,295
Attorney of Record
Customer No. 55389
(619) 235-8550

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